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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,974	10/24/2003	Mark Albert Feucht	36636-198231	6977

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EXAMINER

KWIECINSKI, RYAN D

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3635

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/691,974	Applicant(s) FEUCHT ET AL.	
	Examiner Ryan D. Kwiecinski	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application:
 4a) Of the above claim(s) 5 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
- 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
- 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species III readable on claims 1-4, 6-9, and 11-13 in the reply filed on 6 March 2007 is acknowledged. The traversal is on the ground(s) that including claims reading on Species I would not place additional burden on the Examiner. Also Applicant states that the reasons for indicating Species III distinct and separate from Species I are disputable. This is not found persuasive because Species I does not contain the upwardly projecting flange in the second wall of the rigid flashing which accommodates the edge of the second flexible flashing member. This in turn creates a different connection means between the first and second flashing members requiring a different search within class 52 as well as a different text search. Therefore the Examiner's requirement for an election is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claims 5 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6 March 2007.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states,

"the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

Figures 1 - 12 appear to be informal drawings as reference numerals and lead lines are hand-written and hand-drawn, respectively. Formal drawings are now required.

The drawings are objected to because:

(1) The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "12", Figure 4 has been used to designate both a longitudinal depression and a side edge of the glazing element. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

(2) Figure 9, reference numeral (200) refers to a mounting nail, but the lead line is directed to the sheathing of the roof.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

(1) Page 7, line 26, reference numeral (143a) should be --134a--.

Appropriate correction is required.

Claim Objections

Claims 1-2, 6-7, 8-9, and 11 are objected to because of the following informalities:

Claim 1, line 4, the recitation “substantially rigid” is vague, indefinite, and confusing because it is unclear what is meant by substantially rigid, is the material rigid or is it not?

Claims 1-2 and 8-9, line 2, the recitation “upwards” should be –upwardly—

Claim 2, line 3, the recitation “generally L-shaped” is vague, indefinite, and confusing because it is unclear what is meant by “generally L-shaped” because the brackets are either “L-shaped” or they are not.

Claim 6, lines 1, 3, and 7, the recitations “substantially rectangular” and “substantially rigid” are vague, indefinite, and confusing because it is unclear what is meant by the recitation of “substantially”, either the frame and window components are rectangular or they are not. The same is true with the rigid material, either the material is rigid or it is not.

Claim 7, line 3, the recitation “generally L-shaped” is vague, indefinite, and confusing because it is unclear what is meant by “generally L-shaped” because the brackets are either “L-shaped” or they are not.

Claim 11, lines 1, 3, and 7, the recitations “substantially rectangular” and “substantially rigid” are vague, indefinite, and confusing because it is unclear what is meant by the recitation of “substantially”, either the frame and window components are rectangular or they are not. The same is true with the rigid material, either the material is rigid or it is not.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,605,020 to Chambers.

Claim 1:

Chambers discloses a flashing component (12,14, Fig.2) for connection with external surfaces of top, side and bottom faces of a main frame component of a roof window assembly to provide a weather-proof joint of the roof window assembly with a surrounding roof-covering, comprising: a first plurality of flashing members (12, Fig.2) of a substantially rigid material (Column 3, lines 36-37) for arrangement against said external top, side and bottom faces (106, Fig.2), and a second plurality of flashing members (14, Fig.2) of a resiliently foldable material (Column 4, lines 26-49), each of said second plurality of flashing members being

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connected (Column 4, lines 50-63) with one of said first plurality of flashing members.

The recitation "for connection with external surfaces of top, side, and bottom faces of a main frame component of a roof window assembly" is considered a use of the flashing component. Chambers flashing component is capable of being connected to a frame component of a roof window assembly.

Claim 14:

Chambers discloses a flashing component as claimed in claim 1, wherein the second plurality of flashing members comprises only flashing members (14, Fig.2) connected with the flashing members of said first plurality (12, Fig.2) for arrangement against the side faces of the main frame component.

Chambers flashing component is capable of arrangement against the side faces of the frame component.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,605,020 to Chambers in view of US 5,806,255 to Verby et al.

Claim 2:

Chambers discloses a flashing component as claimed in claim 1 above, but does not disclose wherein said first plurality of flashing members form a flashing frame including two side members, and wherein at least the side members of the flashing frame are of a generally L-shaped cross-section comprising a first wall part for connection with said external side face of the main frame component and a second wall part for connection with a respective flashing member of said second plurality.

Verby et al. disclose that said first plurality of flashing members form a flashing frame (30, Fig.3) including two side members (flashing on 21a and 12b, Fig.2), and wherein at least the side members of the flashing frame are of a generally L-shaped cross-section (Column 2, lines 36-38) comprising a first wall part (32, Fig.3) for connection with said external side face of the main frame component and a second wall part (34, Fig.3) for connection with a respective flashing member of said second plurality.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the flashing of Chambers into a flashing frame to surround a structure in the roof taught by Verby et al. It would have also been obvious to construct the flashing frame members with an L-shaped profile,

with the first wall part flush with the roofing structure and the second wall part flush with the roof itself, in order to more closely resemble the outer profile of the roofing structure, creating a better waterproof seal.

Claim 3:

Chambers in view of Verby et al. discloses a flashing component as claimed in claim 2 above, Verby et al. also discloses that said second wall part of at least the side members of said flashing frame is formed with an upwards projecting folded portion (54, Fig.4) extending in parallel with said first wall part to define a water channel (Column 3, line 27) along a side of said roof window assembly.

Claim 4:

Chambers in view of Verby et al. discloses a flashing component as claimed in claim 3 above, Chambers also discloses an edge of a respective flashing member of said second plurality (Column 4, lines 50-63) is accommodated in the upwards projecting folded portion.

Claims 6-9, 11-13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,806,255 to Verby et al. in view of US 5,605,020 to Chambers.

Claim 6:

Verby et al. disclose a roof window assembly comprising a substantially rectangular main frame (12, Fig.1) component for stationary connection with supporting means of a roof structure and composed of top (12c, Fig.1), side (12a, 12b, Fig.2) and bottom (Column 2, line 13) members and a substantially rectangular window component (20, Fig.3) with a glazing element engaged along all sides by a window frame (Column 2, lines 14-17), and a flashing component (30, Fig.1) to provide a weather-proof joint of the roof window assembly with a surrounding roof-covering, said flashing component including a first plurality of flashing members (30, surrounding the frame 12, Fig.1), but does not disclose that the first plurality of flashing members are made from a substantially rigid material for arrangement against said external top, side and bottom faces, and a second plurality of flashing members of a resiliently foldable material, each of said second plurality of flashing members being connected with one of said first plurality of flashing members.

Chambers discloses that the first plurality of flashing members are made from substantially rigid material (Column 3, lines 35-42) for arrangement against said external top, side and bottom faces, and a second plurality of flashing members (14, Fig.2) of a resiliently foldable material (Column 4, lines 25-29), each of said second plurality of flashing members being connected (Column 4, lines 50-63) with one of said first plurality of flashing members.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the flashing frame of Verby et al. from a

substantially rigid material taught by Chambers in order to provide the necessary structural rigidity for roofing use. It would have also been obvious to include a second flexible member attached to the first rigid flashing member as taught by Chambers in order to provide a waterproof layer over top of the attachment of the first rigid member to the roof structure preventing water from seeping underneath of the flashing structure.

Claim 7:

Verby et al. in view of Chambers disclose a roof window assembly as claimed in claim 6 above, Verby et al. also disclose wherein said first plurality of flashing members form a flashing frame (30, Fig.3) including two side members (flashing on 21a and 12b, Fig.2), and wherein at least the side members of the flashing frame are of a generally L-shaped cross-section (Column 2, lines 36-38) comprising a first wall part (32, Fig.3) for connection with said external side face of the main frame component and a second wall part (34, Fig.3) for connection with a respective flashing member of said second plurality.

Claim 8:

Verby et al. in view of Chambers disclose a roof window assembly as claimed in claim 7 above, Verby et al. also disclose wherein said second wall part of at least the side members of said flashing frame is formed with an upwards projecting folded portion (54, Fig.4) extending in parallel with said first wall part to define a water channel (Column 3, line 27) along a side of said roof window assembly.

Claim 9:

Verby et al. in view of Chambers disclose a flashing component as claimed in claim 8 above, Chambers also discloses that an edge of a respective flashing member of said second plurality (Column 4, lines 50-63) is accommodated in the upwards projecting folded portion.

Claim 11:

Verby et al. disclose a roof window assembly comprising: a substantially rectangular main frame component (12, Fig.1) for stationary connection with supporting means of a roof structure and composed of top (12c, Fig.1), side (12a, 12b, Fig.2) and bottom (Column 2, line 13) members and a substantially rectangular window component (20, Fig.3) with a glazing element engaged along all sides by a window frame (Column 2, lines 14-17), a flashing component (30, Fig.1) to provide a weather-proof joint of the roof window assembly with a surrounding roof-covering, said flashing component including a first plurality of flashing members (30, surrounding the frame 12, Fig.1), and a number of mounting brackets (22, Fig.1) fastened to at least the side members (12a, 12b, Fig.2) of the main frame component, but does not disclose that the first plurality of flashing members are made from a substantially rigid material for arrangement against said external top, side and bottom faces, and a second plurality of flashing members of a resiliently foldable material, each of said second plurality of flashing members being connected with one of said first plurality of flashing members.

Chambers discloses that the first plurality of flashing members are made from substantially rigid material (Column 3, lines 35-42) for arrangement against said external top, side and bottom faces, and a second plurality of flashing members (14, Fig.2) of a resiliently foldable material (Column 4, lines 25-29), each of said second plurality of flashing members being connected (Column 4, lines 50-63) with one of said first plurality of flashing members.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the flashing frame of Verby et al. from a substantially rigid material taught by Chambers in order to provide the necessary structural rigidity for roofing use. It would have also been obvious to include a second flexible member attached to the first rigid flashing member as taught by Chambers in order to provide a waterproof layer over top of the attachment of the first rigid member to the roof structure preventing water from seeping underneath of the flashing structure.

Claim 12:

Verby et al. in view of Chambers disclose a roof window assembly as claimed in claim 11 above, Verby et al. also disclose wherein each mounting bracket comprises a first leg (24, Fig.4) fastened to one of the side members of the main frame and a second leg (26, Fig.4) resting on a sheathing (42,46, Fig.4) of the roof structure.

Claim 13:

Verby et al. in view of Chambers disclose a roof window assembly as claimed in claim 12 above, Verby et al. also disclose wherein at least one opening (28, Fig.1) for a mounting means is provided in the second leg (26, Fig.1) of each mounting bracket, but does not disclose that the opening for a mounting means is at a position to be subsequently covered by the resiliently foldable material of said second plurality of flashing members.

Chambers discloses that the opening for a mounting means (108, Fig.2) is at a position to be subsequently covered by the resiliently foldable material (14, Fig.2) of said second plurality of flashing members.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a second resiliently foldable material taught by Chambers in order to cover the opening for the mounting means in the mounting bracket of the skylight system of Verby et al. in order to seal the opening from the intrusion of water, which will prevent water from seeping underneath the flashing structure.

Claim 15:

Verby et al. in view of Chambers disclose roof window assembly as claimed in claim 6 above, Chambers discloses that the second plurality of flashing members comprises only flashing members (14, Fig.2) connected with the flashing members of said first plurality (12, Fig.2) for arrangement against the side faces of the main frame component.

Claim 16:

Verby et al. in view of Chambers disclose a roof window assembly as claimed in claim 11 above, Chambers discloses that the second plurality of flashing members comprises only flashing members (14, Fig.2) connected with the flashing members of said first plurality (12, Fig.2) for arrangement against the side faces of the main frame component.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan D. Kwiecinski whose telephone number is (571)272-5160. The examiner can normally be reached on Monday - Friday from 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571)272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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